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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/932,915	08/20/2001	Kazuhiko Yamauchi	NAK1-AZ37b	9300

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SNELL & WILMER LLP
1920 MAIN STREET
SUITE 1200
IRVINE, CA 92614-7230

EXAMINER

NGUYEN, HUY THANH

ART UNIT	PAPER NUMBER
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2615

DATE MAILED: 07/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/932,915

Applicant(s)

YAMAUCHI ET AL.

Examiner

HUY T NGUYEN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 29 is/are allowed.
- 6) ☒ Claim(s) 27,28 and 30-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/837,271.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 30 –34 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 30 directs to information stored on an optical disc. Since the information does not provide any functional interrelationship to an optical disc to control the optical disc to access stored information, or impart to any software and hardware structural component to perform a certain function that is processed by a computer, the information stored on the medium does not make them statutory. See MPRP 2100.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 27-28 and 30-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Taira et al (5,636,200).

Regarding claim 30, Taira discloses an optical disc (Figs. 22-31, column 8, lines 9-33, column 9, line 42 –69, columns 10-12)) comprising

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a plurality pieces information of a plurality of titles (cells or program cells);
route information defining a reproduction route by specifying at least one
reproduction order of the plurality of pieces information, the reproduction order of
cells is defined in program chain information or defined by the user (Fig. 24); and
disc reproduction information including branch status information indicating for
each title whether a branch during its reproduction (Figs. 23 and 27).

Further for claim 27, Taira further teaches that the branch information is
determined by a reproduction unit (angle change or switching program chain) (Fig.
24).

Regarding claim 28, Taira further teaches flag information indicating the order of
reproduction is determined by flag value (flag information) (figs.21-24).

Regarding claims 31-33, Taira further teaches a command region that
comprises branch information (Figs. 15 and 27-33).

Regarding claim 34, Taira further teaches menu information and a disc
reproduction device (Figs 9-10).

Regarding claim 35, Taira further teaches reading means for reading the route
information and branch information and the image information (fig. 9, columns 8 and
9).

Regarding claim 36, Taira further teaches searching information (Fig. 21-24);

Regarding claim 37, Nomura further teaches means for displaying an index
number (Figs 37-38, column 15)).

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5. Claims 27-28 and 30-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Nonomura et al (5,915,067).

The applied reference has common inventors with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding claims 27 and 30, Nonomura discloses an optical disc (Figs. 5-9, columns 11 and 12) comprising

a plurality pieces information of a plurality of titles (cells or program cells);
route information defining a reproduction route by specifying at least one reproduction order of the plurality of pieces information; and

disc reproduction information including branch status information indicating for each title whether a branch during its reproduction.

Further for claim 27, Nonomura teaches route information for a fixed order and branch information for variable reproduction (column 13, column 15, lines 52-16, line 9).

Regarding claim 28, Nomura further teaches flag information (Fig. 12) .

Regarding claims 31-33, Nonomura further teaches a command region that comprises branch information (Figs. 5,7,8 and 12).

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Regarding claim 34, Nonomura further teaches menu information (Figs. 13 and 18).

Regarding claim 35, Nonomura further teaches reading means for reading the route information and branch information and the image information (Figs 13 and 15);

Regarding claim 36, Nonomura further teaches searching information (Fig. 20);

Regarding claim 37, Nonomura further teaches means for displaying an index number (Fig. 18 and 20).

Allowable Subject Matter

6. Claim 29 is allowed.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Taira et al teaches apparatus for recording information for branching programs.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUY T NGUYEN whose telephone number is (703) 305-4775. The examiner can normally be reached on 8:30AM -6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Christensen can be reached on (703) 308-9644. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

H.N


HUY NGUYEN
PRIMARY EXAMINER